THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte FRANCOIS CLEMENCE, ODILE LE MARTRET,
FRANCOISE DELEVALLEE, and MICHEL FORTIN,

_____

Appeal No. 1997-1280
Application No. 08/356,912

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HEARD: March 7, 2000

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Before JOHN D. SMITH, WARREN, and LIEBERMAN, ***Administrative Patent Judges.***

LIEBERMAN, ***Administrative Patent Judge***.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the examiner's refusal to allow claims 31 through 33 which are all the claims in the application.[1]

THE INVENTION

The invention is directed to enantiomers and diastereoisomers of N-[2,3-dihydro-2-(1-pyrrolidinyl)-1H-inden-1-yl]-N-methyl-benzene- acetamide derivatives. The derivatives

[1] Claims 28 through 30 are objected to as depending on a rejected base claim. See Answer, page 1.

are directed to substituents on the benzene ring and to R_1 and R_2 substituents on atom number 3 of the indane structure. Three alternatives are included in the claimed subject matter. If the substituents on the benzene ring are both NO_2, then R_1 and R_2 on the indane structure are unsubstituted. If one substituent on the benzene ring is NO_2 and the other is hydrogen, then both R_1 and R_2 substituents on atom number 3 of the indane structure must be other than hydrogen. If the substituents on the benzene ring are selected from the group of hydrogen, alkyl, $-CF_3$, $-NH_2$, sulfamino, and mono and dialkyl amino, then R_1 and R_2 on the indane structure contains two constituents individually selected from the group consisting of hydrogen, alkyl of 1 to 5 carbon atoms or together with the carbon atom to which they are attached form cycloalkyl of 3 to 6 carbon atoms.

THE CLAIMS

Claim 33 is illustrative of appellants' invention and is reproduced in the attached appendix.

THE REFERENCE OF RECORD

As evidence of obviousness, the examiner relies upon the following reference.

Pennev et al. (Pennev)	4,876,269	Oct. 24, 1989

THE REJECTION

Claims 31 through 33 stand rejected under 35 U.S.C. § 103 as unpatentable over Pennev.

OPINION

We have carefully considered all of the arguments advanced by appellants and the examiner and agree with the examiner that the aforementioned rejection under 35 U.S.C. § 103 is well founded. Accordingly, we sustain the examiner's rejection.

The Rejection under § 103

As an initial matter, appellants submit that claims 31 through 33 stand or fall together for purposes of this appeal. See Brief, page 3. Accordingly, we select claim 33, the sole independent composition claim as representative of appellants' invention and limit our consideration to said claim. 37 CFR § 1.192(c)(7) 1995.

There is no dispute as to establishment of a *prima facie* case of obviousness. Appellants do not even argue the question and we can assume *prima facie* obviousness as they appear to do. The issue before us, is whether appellants have overcome the reference to Pennev by their evidence submitted under 37 CFR § 1.132.

Appellants have submitted three Declarations by Michel Fortin under 37 CFR § 1.132. Appellants argue that two showings of record clearly demonstrate the patentable features of the claimed compounds, which showings are commensurate in scope with the

present claims. See Brief, page 3. However, on the record before us there are three Declarations of Michel Fortin.

The first Declaration submitted, February 8, 1995, as part of a preliminary amendment compares N-[2,3-dihydro-2-(1-pyrrolidinyl)-1H-inden-1-yl]-3,4-dimethoxy-N-methyl-benzene- acetamide, representative of the prior art, with N-[2,3-dihydro-2-(1-pyrrolidinyl)-1H-inden-1-yl]-4-trifluoromethyl-N-methyl-benzene- acetamide, compound 5 of the specification and N-[2,3-dihydro-2-(1-pyrrolidinyl)-1H-inden-1-yl]-2,4-dinitro-N-methyl-benzene- acetamide, compound 18 of the specification. Declarant tested the ability of the compounds as analgesics by measuring the concentration of the product necessary to displace 50% of specific radioactivity fixed on the receptor studied. The tests showed that the examples of the invention, compounds 5 and 8, needed to be present in a far smaller concentration than the dimethoxy compound of the prior art.

The second Declaration, submitted July 20, 1995, made the same comparison using the same prior art compound, examples 5 and 18 of the specification, but additionally included Example 28 of the specification, N-[2,3-dihydro-2-(1-pyrrolidinyl)-1H-inden-1-yl]-4-nitro-N-methyl-benzene- acetamide. Declarant again tested the ability of the compounds as analgesics by measuring the concentration of the product necessary to displace 50% of specific radioactivity fixed on the receptor studied. The tests likewise showed that the

examples of the invention needed to be present in a far smaller concentration than the dimethoxy compound of the prior art.

A third Declaration again compared N-[2,3-dihydro-2-(1-pyrrolidinyl)-1H-inden-1-yl]-3,4-dimethoxy-N-methyl-benzene- acetamide of the prior art with the compounds of Examples 6, 7 and 19, N-[2,3-dihydro-2-(1-pyrrolidinyl)-1H-inden-1-yl]-N-methyl-3-trifluoromethyl-benzene- acetamide, N-[2,3-dihydro-2-(1-pyrrolidinyl)-1H-inden-1-yl]-N-methyl-2-trifluoromethyl-benzene- acetamide, and 3,5-bis(trifluoromethyl)-N-[2,3-dihydro-2-(1-pyrrolidinyl)-1H-inden-1-yl]-N-methyl-benzene- acetamide, respectively. The tests likewise showed that the examples of the invention needed to be present in a far smaller concentration than the dimethoxy compound of the prior art.

Appellants argue that, “the showings of record clearly demonstrate the patentable features of the claimed compounds with respect to those of the Pennev et al. reference and that the showings are commensurate in scope with the present claims.” See Brief, page 3. We disagree.

Having reviewed the data present, we conclude that appellants have not met their burden of showing unexpected results. ***In re Klosak***, 455 F.2d 1077, 1080, 173 USPQ 14, 16 (CCPA 1972). It is not sufficient to assert that the results obtained are unusual or unexpected. The burden of showing unexpected results rests on them who assert them.

Appellants have asserted that there is a showing of unexpected properties in the Declarations of record. We determine that the argument is unpersuasive, because the species utilized in the Declaration, N-[2,3-dihydro-2-(1-pyrrolidinyl)-1H-inden-1-yl]-3,4-dimethoxy-N-methyl-benzene- acetamide, representative of the prior art, is not prepared by Pennev. Moreover, Pennev clearly teaches another species, N-[2,3-dihydro-2-(1-pyrrolidinyl)-1H-inden-1-yl]-3,4-dichloro-N-methyl-benzene- acetamide within the scope of the claimed subject matter other than for the presence of the 3,4-dichloro groups. See Example 6. We determine that Example 6 is the closest example to the claimed subject matter. Moreover, the compound of Example 6, is also one of the appellants preferred, but unclaimed compounds. See specification, page 5, lines 6-8. Hence, the comparative examples which fail to include that compound do not reflect the closest prior art relied upon in our opinion. ***In re Baxter Travenol Labs.***, 952 F.2d 388, 392, 21 USPQ2d 1281, 1285 (Fed. Cir. 1991); ***In re De Blauwe***, 736 F.2d 699, 705, 222 USPQ 191, 196 (Fed. Cir. 1984). In addition, it is well settled that direct or indirect testing between the claimed compounds and the closest prior art may be necessary**.** ***In re Merchant*** 575 F.2d 865, 869, 197 USPQ 785, 788 (CCPA 1978).

Furthermore, each of the tests conducted by declarant Fortin, uses the same single species of prior art compound. i.e., N-[2,3-dihydro-2-(1-pyrrolidinyl)-1H-inden-1-yl]-3,4-dichloro-N-methyl-benzene- acetamide. It is well settled that, “where an applicant tests less

than all the cited compounds, the test must be sufficient to permit a conclusion regarding the relative effectiveness of applicant's claimed compounds and the compounds of the closest prior art." ***In re Payne*** 606 F.2d 303, 316, 203 USPQ 245, 256 (CCPA 1979).

No such conclusion can be reached based upon the evidence presented herein. The claimed subject matter is directed broadly to a genus containing more than 100 members of N-[2,3-dihydro-2-(1-pyrrolidinyl)-1H-inden-1-yl]-N-methyl-benzene- acetamides. Similarly, the prior art to Pennev contains numerous compounds falling within the class of formula (II) and within the scope of the claimed subject matter. See column 3, line 12 through column 3, line 2. Based upon the above considerations, we conclude that the evidence submitted in the case is insufficient to rebut a *prima facie* case of obviousness because the claimed compounds are compared with only one prior art compound. See ***In re Chupp*** 816 F.2d 643, 646, 2 USPQ2d 1437, 1439-40 (Fed. Cir. 1987) explaining the decision in ***In re Payne*** 606 F.2d 303, 316, 203 USPQ 245, 256 (CCPA 1979).

Based on the record before us, we find that the results demonstrated in the comparative examples found in the Declarations of Fortin are not based on the closest prior art and are entitled to little, if any, weight with respect to the patentability of the claimed subject matter over the teachings of Pennev. See ***In re Burckel***, 592 F.2d 1175, 1180, 201 USPQ 67, 71 (CCPA 1979).

Based on our consideration of the totality of the record before us, and having evaluated the ***prima facie*** case of obviousness in view of appellants' arguments and evidence, we conclude that the preponderance of evidence weighs in favor of obviousness of the claimed subject matter within the meaning of § 103. See ***In re Oetiker***, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

DECISION

The rejection of claims 31 through 33 under 35 U.S.C. § 103 as unpatentable over Pennev is affirmed.

The decision of the examiner is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

JOHN D. SMITH Administrative Patent Judge	)))))) BOARD OF PATENT
CHARLES F. WARREN Administrative Patent Judge	) APPEALS) AND) INTERFERENCES
PAUL LIEBERMAN Administrative Patent Judge	))))

PL/jlb

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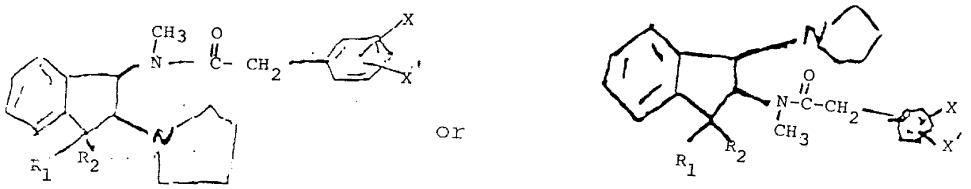
APPENDIX

33. A compound selected from the group consisting of enantiomers and diastereoisomer forms and mixtures thereof of a compound of the formula



pharmaceutically acceptable acid addition salts.

wherein X is $-NO_2$ and X' is hydrogen and their non-toxic, mono and dialkyl amino and c), R_1 and R_2 are other than hydrogen the group consisting of hydrogen, alkyl, $-CF_3$, $-NH_2$, sulfamino and 3 to 6 carbon atoms, then X and X' are individually selected from with the carbon atom to which they are attached form cycloalkyl of consisting of hydrogen, alkyl of 1 to 2 carbon atoms or fodefher hydrogen d) when R_1 and R_2 are individually selected from the group wherein a) when X and X' are both $-NO_2$, then R_1 and R_2 are both